1. What are Geographical Indications (GIs)?

a. Definition of GIs

The term ‘Geographical Indication’ (GI) was first introduced by the Agreement on Trade-Related Aspects of Intellectual Property Right (TRIPS) of the World Trade Organization (WTO), which came into force in 1995. Article 22.1 of the TRIPS Agreement defines GIs as ‘indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or another characteristic of the good is essentially attributable to its geographical origin.’

A GI is therefore a sign — generally the name of a territory — used to identify goods that come from that specific geographical place and possess qualities, characteristics or a reputation that are due to that origin. This is the case with ‘Rioja’ for wines from the Spanish region of Rioja and ‘Prosciutto di Parma’ from the region of Parma in Italy, among many others. However, a geographical name, merely noting a source of origin (for example ‘Made in Vietnam’), cannot be considered a GI. A GI must communicate that the distinctive characteristics, specificities, unique quality, etc. of a product have an inseparable link with the geographical environment, natural resources, traditional practices of production and local culture of the place where it is produced.

There are many examples of GIs throughout the world, well-known names that are associated with products of a certain reputation and quality from a specific region.

1 The TRIPS Agreement is Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, signed in Marrakesh, Morocco on 15 April 1994.
These benefits are being progressively appreciated in the opportunities. In the European market, a strengthened brand, and greater export distribution of profits, and a competitive advantage in practices and provide better economic gains, a better benefits, including high-quality production systems that in

In the European market, the GI protection provides many benefits, including high-quality production systems that in many cases use transparent and sustainable production practices and provide better economic gains, a better distribution of profits, and a competitive advantage in the market, a strengthened brand, and greater export opportunities.

These benefits are being progressively appreciated in the South-East Asia (SEA) region, resulting in the establishment of legal frameworks to recognise and protect GIs in most countries of the Association of South-East Asian Nations (ASEAN), with an increasing number of local high quality product names identified and protected as GIs in countries such as Cambodia, Indonesia, Malaysia, Thailand and Vietnam.

The strong economic growth, driven primarily by the consumption of a growing middle-class population, has also attracted the interest of today’s SEA consumers in higher quality products, including those imported from overseas. This opens up a wide range of attractive opportunities for GIs in SEA markets, as European products are generally considered to be of high quality.

<table>
<thead>
<tr>
<th>Table 1: Some examples of GIs around the world</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>EUROPEAN UNION</strong></td>
</tr>
<tr>
<td>Wachauer (Marille apricot – Austria)</td>
</tr>
<tr>
<td>Brussels grondwitoof (Chicory heads – Belgium)</td>
</tr>
<tr>
<td>Šoltansko maslinovo ulje (Olive oil – Croatia)</td>
</tr>
<tr>
<td>Chamomilla bohemica (Spices – Czech Republic)</td>
</tr>
<tr>
<td>Champagne (Wine – France)</td>
</tr>
<tr>
<td>Bremer Bier (Beer – Germany)</td>
</tr>
<tr>
<td>Parmigiano Reggiano (Cheese – Italy)</td>
</tr>
<tr>
<td>Daujenų namine duona (Bread – Lithuania)</td>
</tr>
<tr>
<td>Karp zatorski (Fish – Poland)</td>
</tr>
<tr>
<td>Porto / Port / vinho do Porto / Port Wine / vin de Porto / Oporto / Portvin / Portwein / Portwijn (Wine – Portugal)</td>
</tr>
<tr>
<td>Ternera Gallega PGI (Veal – Spain)</td>
</tr>
<tr>
<td>Irish Whiskey / Ulse Beatha Eireannach / Irish Whisky GI (Spirits – Ireland)</td>
</tr>
</tbody>
</table>

**b. Why are GIs important?**

GI names have a reputation that inspire trust and are recognised by traders and consumers, who are ready to pay a higher price for them. The link to the place of origin comes from the products’ histories, the impact of the geographical environment on production and processing conditions and/or the specific know-how used in the different stages of production.

In the European market, the GI protection provides many benefits, including high-quality production systems that in many cases use transparent and sustainable production practices and provide better economic gains, a better distribution of profits, and a competitive advantage in the market, a strengthened brand, and greater export opportunities.

Legislation in some countries, like Thailand, Malaysia or Singapore, has incorporated a wide range of goods as eligible to be protected as GIs; these include natural and agricultural products, foodstuffs, wines and spirits, as well as handicraft and industrial products. Conversely, legal frameworks in Vietnam, Indonesia, Cambodia and Laos remain silent on the matter, but do not include any restriction on the GI scope either, meaning that any kind of goods can be protected as GIs in these countries.

As a result, processed meat (e.g. hams and sausages), fresh meat, fresh fish, molluscs, crustaceans, other products of animal origin (e.g. eggs and honey), fruits and vegetables, cereals, oils, dairy products (e.g. cheeses), beers, bakery products, spices, coffee, condiments, wines and spirits, as well as handicraft products (e.g. textiles, wood, leather, knives, ceramics, jewellery, musical instruments, etc.) can all be recognised and protected as GIs in ASEAN countries.

The specific (i.e. *sui generis*) GI legal framework at European Union (EU) level only encompasses protection of agricultural products, such as wines, spirits, aromatised wines, agricultural products and foodstuffs. On their side, many non-agricultural products enjoy such specific GI protection at national level and EU collective and national trade marks also provide some protection.

**c. Differences between the EU and countries in South-East Asia**

The GI definition in the TRIPS Agreement is open to any kind of goods, as it is in all ASEAN countries, which are committed to complying with the definition of a GI stipulated in the Agreement while adapting the GI scope to the reality of their specific economies.

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2. How are GIs generally protected?

Protecting GIs is crucial to prevent traditional products from disappearing, as they cannot compete with conventional products with lower production costs. It also avoids damage to products’ reputations and misleading consumers. However, as with other intellectual property rights (IPR), there is no common legal framework for the protection of GIs at ASEAN level, thus the legal framework in each country of the SEA region differs in the way it ensures its compliance with the TRIPS Agreement.

Briefly explained, the protection of GIs in SEA countries may be conferred in different ways:

a. Sui generis system

This is a special regime, established through laws and by-laws related to GIs, which confers collective rights to producers and/or processors who respect the conditions established in the GI product specifications (technical specifications/file of the GI product) in a defined geographical area. It comprises, among other aspects, an examination procedure, the legal inscription in an official public list or register, the protection against a wide range of unlawful commercial practices, and the enforcement of this protection by public authorities.

The GI protection under the sui generis system is usually for an indefinite period, as long as the product complies with the specifications or the GI right is not voluntarily renounced.

As well as existing in the EU and in other countries around the world, the sui generis system is established in the following ASEAN countries: Cambodia, Indonesia, Laos, Malaysia, Thailand, Vietnam and recently also in Singapore.

b. Protection under trade mark laws

Some SEA countries protect GIs under trade mark laws, more specifically as collective marks or certification marks.

Besides the usual requirements for a trade mark to be considered lawful (distinguishing goods or services from others in the same category and avoiding confusion among consumers), collective trade marks are mainly used to guarantee a product’s characteristics (such as its geographical origin) and they are owned by a public or private group (e.g. a trade association) that allows their members to use them commercially, while certification marks indicate that a product has been produced subject to given standards (such as a geographical region of production) and they are the property of a group which does not trade the product itself but certifies the compliance of the product to such standards.

The duration of the protection offered to GIs registered as collective or certification marks can vary from one country to another (usually ten years), but the mark can be renewed for equal periods indefinitely, through a renewal application and the payment of a fee.

Protection under trade mark laws is possible in countries like Australia or the United States of America. Likewise, ASEAN countries, like the Philippines, Brunei and Myanmar, protect GIs through certification or collective trade marks under national trade mark laws (though the Philippines and Brunei are currently exploring the development of a specific GI system in a near future).

c. Protection against unfair competition and ‘passing-off’

The third type of GI protection, also developed differently in different countries, may be conferred through legal provisions regarding business practices, such as laws relating to the repression of unfair competition or actions that pass-off one product as another.

Laws for the repression of unfair competition provide an effective remedy against unlawful and dishonest commercial practices (e.g. misleading the public about the geographical origin of products). In order to prevent the unauthorised use of a GI through an action against unfair competition, the use of the GI by an unauthorised party must be shown to be misleading and that damages or the likelihood of damages have resulted from that use. This action can only be successful if the public associates goods sold under your GI with a distinct geographical origin and/or certain qualities.

Protection against passing-off is a legal remedy for cases in which someone presents products similar to other ones, misleading consumers and making them believe that they are buying authentic goods when they are actually obtaining inauthentic goods. In order to prevent the unauthorised use of a GI through a successful action against passing-off, you must establish the goodwill or reputation of the GI goods which you supply, the infringer’s misrepresentation to the public regarding those goods and the damage you are likely to suffer from such misrepresentation.

All ASEAN countries have laws relating to the repression of unfair competition or actions of passing-off, under which you may protect yourself against the unauthorised use of your GI. However, it can be challenging to demonstrate the legitimate GI right, the distinctiveness of the product and the probable damages resulting from unauthorised use.
d. Legal instruments

The various approaches available to protect GIs involve important differences on aspects like the conditions for protection, the scope of protection, the duration of protection, etc.

When several of these systems are in place in a country, a number of factors for choosing the appropriate system to protect your GI must be considered:

- **Assess the GI protection system in the country of origin**: in order to register your GI in SEA, this GI must also have been protected in its country of origin.
- **Assess the means of protection available in the country** *(sui generis, collective/certification marks, etc.)*, including requirements, procedures and costs.
- **Undertake research** in order to rule out possible conflicts between GIs and prior rights (such as previously registered trade marks).
- **Examine the protection system best adapted to your requirements**, not only in terms of compliance with national requirements but also regarding the levels of protection available and IPR enforcement.

To assess the best GI protection options in a target country, as well as to facilitate the registration procedure, seeking the advice of local intellectual property (IP) experts is highly advisable.

Further to the various ways to protect a GI in ASEAN countries, European GIs can also be protected if the EU has a bilateral or regional agreement with an ASEAN country that includes the protection of those GIs.

3. Protecting EU GIs in South-East Asia

a. Type of protection

Broadly speaking, GIs are protected through a wide variety of systems and approaches across different SEA countries. In some jurisdictions, it is even possible to combine different means of protection. This is the case in Vietnam, where products can be registered as GIs, but registration of GIs as collective/certification marks is also allowed. Thus, modes of protection for GIs do not necessarily apply on an exclusive basis.

Check out our table page 5 with information for the different SEA countries grouped under type of protection, legal framework, and useful remarks.

b. Getting protected

Who can apply for registration?

Some SEA countries clearly identify who can apply to register a GI while others do not make a specific reference to the applicant. Check out our table page 6 with information on the applicant for GI registration in the different SEA countries.

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3 Currently there are two FTAs (‘EUSFTA’ with Singapore and ‘EVFTA’ with Vietnam) under implementation in the region, and one being negotiated (with Indonesia). These agreements include comprehensive provisions on GIs and lists of protected GIs under the Agreement. The texts of EUSFTA and EVFTA can be found [here](#) and for Indonesia [here](#).

Table 2: Different legal systems for the protection of GIs in ASEAN

<table>
<thead>
<tr>
<th>COUNTRY</th>
<th>Sui generis GI Protection</th>
<th>TRADE MARK SYSTEM</th>
<th>UNFAIR COMPETITION PROTECTION</th>
</tr>
</thead>
<tbody>
<tr>
<td>BRUNEI</td>
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<td>CAMBODIA</td>
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<td>INDONESIA</td>
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<td>LAOS</td>
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<td>MALAYSIA</td>
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<td>MYANMAR</td>
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<td></td>
<td>(to be implemented)</td>
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<tr>
<td>THE PHILIPPINES</td>
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<tr>
<td>SINGAPORE</td>
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<td>THAILAND</td>
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<td>VIETNAM</td>
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</table>
## Type of protection, legal framework, and useful remarks.

<table>
<thead>
<tr>
<th>SEA COUNTRY</th>
<th>TYPE OF PROTECTION</th>
<th>LEGAL FRAMEWORK</th>
<th>USEFUL REMARKS</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>BRUNEI</strong></td>
<td>No Sui generis GI system</td>
<td>- Trade marks Act (Chapter 9B), on its revised edition of 30 December 2000. - Implementing and amending rules.</td>
<td>The Brunei Intellectual Property Office (BruIPO), with the support of the EU (IP Key SEA Project), is undertaking consultation meetings with stakeholders on the possible development of a Sui generis GI system, which might significantly change current GI protection in the country in the near future.</td>
</tr>
<tr>
<td><strong>CAMBODIA</strong></td>
<td>Sui generis GI system</td>
<td>- Law on GIs of 20 January 2014. - Prakas No. 105 MOL/C/SM/2009 on the Procedures for the Registration and Protection of Marks of Goods, which include a GI.</td>
<td>The Laos Intellectual Property Office (Lipo) is undertaking consultation meetings with stakeholders on the possible development of a Sui generis GI system, which might significantly change current GI protection in the country in the near future.</td>
</tr>
<tr>
<td><strong>INDONESIA</strong></td>
<td>Sui generis GI system</td>
<td>- Law No. 20/2016 on Marks and GIs. - Ministerial Regulation No. 12 promulgated on 25 June 2019 concerning GIs.</td>
<td>The new Trade mark Law was approved on 30 January 2019 but it is still being implemented. Despite the fact that particular implementing aspects are still to be developed, all information in this guide regarding GI registration in Myanmar refers to the new legislation as it will be implemented in the coming months. Until the new law is implemented, you can only protect your GI on the basis of prior use or by recording a Declaration of Ownership of your GI with the Registry of Deeds and Assurance in Yangon or Mandalay, as proof of your right to act against infringements.</td>
</tr>
<tr>
<td><strong>LAOS</strong></td>
<td>Sui generis GI system</td>
<td>Decision No. 1119/MOST on the Implementation of GIs, under the Law on Intellectual Property No. 01/NA of 20 December 2011.</td>
<td>The new Trade mark Law was approved on 30 January 2019 but it is still being implemented. Despite the fact that particular implementing aspects are still to be developed, all information in this guide regarding GI registration in Myanmar refers to the new legislation as it will be implemented in the coming months. Until the new law is implemented, you can only protect your GI on the basis of prior use or by recording a Declaration of Ownership of your GI with the Registry of Deeds and Assurance in Yangon or Mandalay, as proof of your right to act against infringements.</td>
</tr>
<tr>
<td><strong>MALAYSIA</strong></td>
<td>No Sui generis GI system</td>
<td>- Geographical Indications Act 2000, amended by the A1141 GIs (Amendment) Act 2002. - GIs Regulations 2001, amended by the PU (A) 225 Gis (Amendment) Regulations 2013.</td>
<td>The new Trade mark Law was approved on 30 January 2019 but it is still being implemented. Despite the fact that particular implementing aspects are still to be developed, all information in this guide regarding GI registration in Myanmar refers to the new legislation as it will be implemented in the coming months. Until the new law is implemented, you can only protect your GI on the basis of prior use or by recording a Declaration of Ownership of your GI with the Registry of Deeds and Assurance in Yangon or Mandalay, as proof of your right to act against infringements.</td>
</tr>
<tr>
<td><strong>MYANMAR</strong></td>
<td>GI registration under the new trade mark law (to be implemented)</td>
<td>Pyidaungsu Htuttaw Law No. 3/2019 (new Trade Mark Law) of 30 January 2018 (to be implemented).</td>
<td>The new Trade mark Law was approved on 30 January 2019 but it is still being implemented. Despite the fact that particular implementing aspects are still to be developed, all information in this guide regarding GI registration in Myanmar refers to the new legislation as it will be implemented in the coming months. Until the new law is implemented, you can only protect your GI on the basis of prior use or by recording a Declaration of Ownership of your GI with the Registry of Deeds and Assurance in Yangon or Mandalay, as proof of your right to act against infringements.</td>
</tr>
<tr>
<td><strong>PHILIPPINES</strong></td>
<td>No Sui generis GI system yet GI protection through collective marks under trade mark law</td>
<td>- Republic Act No. 8293 Intellectual Property Code (IP Code) on its 2015 Edition. - Memorandum Circular No. 17-010, Rules and Regulations on Trade marks, Service Marks, Trade Names and Marked or Stamped Containers of 2017.</td>
<td>The IP Office of the Philippines (IPOPHL), with the support of the EU (IP Key SEA Project), is currently consulting stakeholders on the possible development of a Sui generis GI system in the Philippines. Some developments on the protection of GIs can be expected in the near future.</td>
</tr>
<tr>
<td><strong>SINGAPORE</strong></td>
<td>Protection as unregistered GIs through a sui generis GI system (establishment currently ongoing) Protection through collective or certification marks under trade mark law</td>
<td>- As unregistered GIs: GIs Act 1998 (Chapter 117) on its Revised Edition of 1999. - As registered GIs: GIs Act 2014 (‘GI Act’) and the GIs Rules 2019 (subsidary legislation). - As collective and certification marks: Trade marks Act (2005 Revised Ed) (Cap. 352), as amended up to the IP (Border Enforcement) Act 2018, together with its subsidiary legislation, the Trade marks Rules and Trade marks (International Registration) Rules.</td>
<td>Unregistered GIs that identify wines or spirits enjoy a higher level of protection under the TRIPS Agreement compared to unregistered GIs that identify other types of product. The new sui generis GI system (‘GI Act’) created a new GI Register to receive applications and confer a high level of protection to agricultural products and foodstuffs. Under the AFTA, a good number of EU GIs will now be protected in Singapore, but the new system allows for the registration of direct GI applications as well.</td>
</tr>
<tr>
<td><strong>THAILAND</strong></td>
<td>Sui generis GI system</td>
<td>- Act on Protection of GI B.E.2546 of 2003. - Related ministerial regulations.</td>
<td>The new Trade mark Law was approved on 30 January 2019 but it is still being implemented. Despite the fact that particular implementing aspects are still to be developed, all information in this guide regarding GI registration in Myanmar refers to the new legislation as it will be implemented in the coming months. Until the new law is implemented, you can only protect your GI on the basis of prior use or by recording a Declaration of Ownership of your GI with the Registry of Deeds and Assurance in Yangon or Mandalay, as proof of your right to act against infringements.</td>
</tr>
<tr>
<td><strong>VIETNAM</strong></td>
<td>Sui generis GI system contained in the trade mark law GI protection through collective or certification marks under trade mark law</td>
<td>- Intellectual Property Law No. 50/2005/QH11 of 29 November 2005. - Implementing and amending regulations.</td>
<td>Under the EVFTA (recently signed but still to enter into force) a number of EU GIs will be protected in Vietnam at a similar level to the protection provided by the EU. However, you can also apply to directly register your GI if you want it to be protected in Vietnam.</td>
</tr>
</tbody>
</table>
### Information on the applicant for GI registration in the different SEA countries.

<table>
<thead>
<tr>
<th>SEA COUNTRY</th>
<th>WHO CAN APPLY FOR REGISTRATION</th>
<th>REPRESENTATION (for foreign GI applications)</th>
<th>USEFUL REMARKS</th>
</tr>
</thead>
</table>
| BRUNEI      | - For collective marks: the GI association  
             - For certification marks: the GI certifying body | Authorised representative (agent) based in Brunei | - The GI association shall be recognised by competent authorities and shall ensure that its members comply with the Book of Specifications (GI Product Specifications) and other legal obligations.  
- The agent shall fulfil sufficient qualification requirements, as specified in the Declaration on Trade Mark Legal Agents. |
| CAMBODIA   | - A non-profit GI association gathering interested producer groups, operators, institutions, and/or interested persons | Legal agent, administrative representative or foreign representative residing and practicing his business in Cambodia | - The GI association shall be recognised by competent authorities and shall ensure that its members comply with the Book of Specifications (GI Product Specifications) and other legal obligations.  
- The agent shall fulfil sufficient qualification requirements, as specified in the Declaration on Trade Mark Legal Agents. |
| INDONESIA  | - An institution that represents the community in the geographical region where goods are produced, consisting of producers, those who do business on goods, or traders of goods  
             - The provincial or district/city government  
             - A group of consumers of the goods | Proxy in Indonesia (a registered IP consultant) or the diplomatic representation in Indonesia of the country of origin of the GI | Database of IP Consultants of the DGIP in Indonesia: http://icoki.dgip.go.id/index.php/pages/index_  
Mark Legal Agents. |
| LAOS        | - A GI association or producers' group  
             - A producers' and/or operators' organisation that may benefit from the GI | Authorised representative in Laos | The association or organisation shall be recognised by the DP of the MOST and shall ensure that its members comply with the Book of Specifications (GI Product Specifications) and other legal obligations.  
- The GI association shall be recognised by competent authorities and shall ensure that its members comply with the Book of Specifications (GI Product Specifications) and other legal obligations. |
| MALAYSIA   | - A person who is carrying on an activity as a producer in the geographical area in respect of the goods specified in the application (including a group or groups of people)  
             - A competent authority  
             - A trade organisation or association | Agent domiciled and carrying out business in Malaysia | The agent must be constituted under Malaysian laws and be registered in the Register of GI Agents maintained by the Central GI office. Otherwise, the Registrar may not recognise the agent.  
Specific aspects of the requirements to be fulfilled by the representative (if any) will be known when the new trade mark law is implemented. |
| MYANMAR     | Any legally formed organisation representing the following persons within the area where the related goods are produced:  
- manufacturers who produce goods using natural products or natural resources  
- producers of agricultural products  
- manufacturers who produce handicrafts or industrial products  
Authorities from relevant government departments and governmental organisations in Myanmar who represent the aforementioned persons | Representative | Specific aspects of the requirements to be fulfilled by the representative (if any) will be known when the new trade mark law is implemented. |
| PHILIPPINES | A corporate entity or registered organisation | Agent or representative (Philippine resident) | – The GI applicant from a foreign country shall:  
- Be a national of a country that is a member to the convention or the agreement among countries concerning protection of GIs to which Thailand is also a member; or  
- Have a domicile or actual business office in Thailand or in the country that is a member of the convention or the agreement among countries concerning protection of GIs to which Thailand is also a member.  
A lawful representative must be an IP agent registered with the National Office of Intellectual Property of Vietnam (IP Vietnam) before providing services. | – The GI applicant from a foreign country shall:  
- Be a national of a country that is a member to the convention or the agreement among countries concerning protection of GIs to which Thailand is also a member; or  
- Have a domicile or actual business office in Thailand or in the country that is a member of the convention or the agreement among countries concerning protection of GIs to which Thailand is also a member.  
A lawful representative must be an IP agent registered with the National Office of Intellectual Property of Vietnam (IP Vietnam) before providing services. |
| SINGAPORE  | - For GI: a producer in the geographical area, an association of producers in the geographical area or a competent authority having responsibility for the GI for which the registration is sought  
             - For collective mark: an association of producers of the goods protected by the GI  
             - For certification mark: a proprietor, in their own name, with the competency to certify and operate the certification scheme, but not supplying goods or services identical to those for which he is certifying | No restriction as to nationality or country of residency, an address for service in Singapore is compulsory | – The GI applicant from a foreign country shall:  
- Be a national of a country that is a member to the convention or the agreement among countries concerning protection of GIs to which Thailand is also a member; or  
- Have a domicile or actual business office in Thailand or in the country that is a member of the convention or the agreement among countries concerning protection of GIs to which Thailand is also a member.  
A lawful representative must be an IP agent registered with the National Office of Intellectual Property of Vietnam (IP Vietnam) before providing services.  
According to the new GI Act 2014, a registrant may apply to the Registrar for a registered GI to be transferred to another person, as long as that person is entitled to file an application for the registration of the GI and consents to having the registration transferred to him. |
| THAILAND   | - A government agency, public body, state enterprise, local administration organisation or other state organisation, covering the area of the geographical origin of the goods  
             - A natural person, group of persons or legal entity engaging in trade related to the goods using the GI and domiciled in the GI area  
             - A group of consumers, or a consumer organisation related to the goods using the GI | Not specified | – The GI applicant from a foreign country shall:  
- Be a national of a country that is a member to the convention or the agreement among countries concerning protection of GIs to which Thailand is also a member; or  
- Have a domicile or actual business office in Thailand or in the country that is a member of the convention or the agreement among countries concerning protection of GIs to which Thailand is also a member.  
A lawful representative must be an IP agent registered with the National Office of Intellectual Property of Vietnam (IP Vietnam) before providing services. |
| VIETNAM    | - Organisations and individuals of Vietnam  
             - Foreign individuals and organisations permanently residing in Vietnam or having a production or trading establishment in Vietnam  
             - Foreign organisations and individuals not permanently residing in Vietnam or not having a production or trading establishment in Vietnam | Lawful representative in Vietnam for foreign individuals and foreign organisations not permanently residing in Vietnam or not having a production or trading establishment in Vietnam | A lawful representative must be an IP agent registered with the National Office of Intellectual Property of Vietnam (IP Vietnam) before providing services. |
Checklist (of items and documents that must be included)

When applying for a GI to be protected with the local IP office or relevant authority in SEA, specific items and documents will be required. Please see our table below, which includes the required items to start the application process in each country.

### Application process in each country. BRUNEI - MALAYSIA

<table>
<thead>
<tr>
<th>Items/documents required to apply for registration</th>
<th>BRUNEI</th>
<th>CAMBODIA</th>
<th>INDONESIA</th>
<th>LAOS</th>
<th>MALAYSIA</th>
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<tbody>
<tr>
<td>Application form/registration request</td>
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<td>Power of attorney/authorisation letter</td>
<td>•</td>
<td>• Notarised</td>
<td>•</td>
<td>•</td>
<td>• Statutory declaration</td>
</tr>
<tr>
<td>Identification of the applicant (name, address, etc.) and/or representative</td>
<td>•</td>
<td>•</td>
<td>•</td>
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<td>•</td>
</tr>
<tr>
<td>Proof of the protection/registration in the country of origin (for foreign GIs)</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Translation of documents</td>
<td>• English</td>
<td>• English</td>
<td>• Bah. Ind. &amp; English</td>
<td>• Lao</td>
<td>• English</td>
</tr>
<tr>
<td>Transliteration of documents (if needed)</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>GI product specifications (GI name/sign, quality, characteristics, reputation, link with the GI area, elaboration, controls, etc.)</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Goods or services to which the GI applies</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Image or reproduction of the GI/mark</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Description/map of GI area</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Other relating documents stipulated in the application</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Regulations governing the use of the collective/certification mark</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Payment of prescribed fees</td>
<td>•</td>
<td>•</td>
<td>•</td>
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</tr>
</tbody>
</table>

*English* • *Lao* • *Bah. Ind. & English* • *Statutory declaration* • *Notarised* • *Statement & evidence on the basis to claim GI status* • *Documents of previous filing abroad* • *Any other particulars as may be prescribed*
### Application process in each country: MYANMAR – VIETNAM

<table>
<thead>
<tr>
<th>Items/documents required to apply for registration</th>
<th>MYANMAR</th>
<th>PHILIPPINES</th>
<th>SINGAPORE</th>
<th>THAILAND</th>
<th>VIETNAM</th>
</tr>
</thead>
<tbody>
<tr>
<td>Application form/registration request</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Power of attorney/authorisation letter</td>
<td>Not specified</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Identification of the applicant (name, address, etc.) and/or representative</td>
<td>•</td>
<td>•</td>
<td>Only address in Singapore &amp; applicant’s nationality</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Proof of the protection/registration in the country of origin (for foreign GIs)</td>
<td>Not specified</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Translation of documents</td>
<td>Burmese or English if requested</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Transliteration of documents (if needed)</td>
<td>•</td>
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<td>•</td>
</tr>
<tr>
<td>GI product specifications (GI name/sign, quality, characteristics, reputation, link with the GI area, elaboration, controls, etc.)</td>
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<td>•</td>
<td>•</td>
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<td>Goods or services to which the GI applies</td>
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<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Image or reproduction of the GI/mark</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Description/map of GI area</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Other relating documents stipulated in the application</td>
<td>Other stipulated matters</td>
<td>A declaration of the actual use of the mark</td>
<td>For GIs: - Applicant’s capacity to apply for registration</td>
<td>- Product’s label/name/statement indicated in the product’s label</td>
<td>- Evidence of continuous use of the GI up to the filing date</td>
</tr>
<tr>
<td>Regulations governing the use of the collective/certification mark</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Payment of prescribed fees</td>
<td>•</td>
<td>•</td>
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</tr>
</tbody>
</table>
c. GI registration process

The procedure to register a GI in SEA countries is managed by the relevant IP authority in each country. IP offices generally undertake a formal examination (in order to assess that all the required information, documents and evidence are provided by the applicant or representative), followed by a substantive examination (to assess the eligibility of the GI under the requirements and corresponding protection scope of each country). In most cases, with sufficient evidence, any interested party may present an opposition or objection requesting the rejection of the application and the refusal of the registration. If no opposition has been filed or, being filed, has not been successful, and the application complies with the requirements for protection, the authority responsible will register the GI, record the relevant information in the official IP gazette, publish the application and issue a registration certificate.

Please see our table below to know more about the specifics of the registration process (languages to be used during the process, the average length of the procedure, estimation of registration costs and relevant authority).

<table>
<thead>
<tr>
<th>SEA COUNTRY</th>
<th>GI REGISTRATION LANGUAGES</th>
<th>AVERAGE LENGTH</th>
<th>ESTIMATION REGISTRATION COSTS (into EUR — as of May 2019)</th>
<th>RESPONSIBLE AUTHORITY</th>
</tr>
</thead>
<tbody>
<tr>
<td>BRUNEI</td>
<td>English</td>
<td>Between 15 and 18 months</td>
<td>Collective/certification mark — registration: BND281 (EUR184) renewal per class: BND200 (EUR131)</td>
<td>Brunei Darussalam Intellectual Property (BruIPO) Level 2, East Wing, Design &amp; Technology Building Simpang 32-37, Kg Anggerek Desa Jalan Berakas Bandar Seri Begawan BB3713 Negara Brunei Darussalam Tel: (673) 2380966 Fax: (673) 2990545 Web: <a href="http://www.bruipo.gov.bn/SitePages/Home.aspx">http://www.bruipo.gov.bn/SitePages/Home.aspx</a></td>
</tr>
<tr>
<td>CAMBODIA</td>
<td>Khmer or English</td>
<td>Between 12 and 18 months</td>
<td>Info not available</td>
<td>Ministry of Commerce (Department of Intellectual Property Rights – D/IPR) Lot 19-61, MOC Road (1138 Road), Phnom Teuk Thla Sangkat Teuk Thla, Khan Sen Sok Phnom Penh Kingdom of Cambodia Tel: (855-23) 866 115, (855-12) 807 346 / (855-11) 888 969 Web: <a href="http://www.cambodiaip.gov.kh">www.cambodiaip.gov.kh</a></td>
</tr>
<tr>
<td>LAOS</td>
<td>Lao or English (to be translated into Lao and certified as true and correct within 90 days from the filing date)</td>
<td>Around 12 months</td>
<td>GI registration through accelerated examination for ASEAN countries that signed an MoU with Laos and already have their GIs registered (Cambodia, Singapore and Vietnam)</td>
<td>Department of Intellectual Property Ministry of Science and Technology P.O. Box: 2279 Sisadorn Road Vientiane Capital, Lao PDR Tel: (856) 21 213 470 (DIP Ext 148) (856) 21 253 111 Fax: (856) 21 213 472 Web: <a href="https://dip.gov.la/">https://dip.gov.la/</a></td>
</tr>
<tr>
<td>SEA COUNTRY</td>
<td>GI REGISTRATION LANGUAGES</td>
<td>AVERAGE LENGTH</td>
<td>ESTIMATION REGISTRATION COSTS (Into EUR — as of May 2019)</td>
<td>RESPONSIBLE AUTHORITY</td>
</tr>
<tr>
<td>-------------</td>
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</tr>
<tr>
<td>MYANMAR</td>
<td>Burmese or English; to be translated into Burmese or into English if requested</td>
<td>Info not available</td>
<td>Info not available</td>
<td>Department of Research and Innovation Ministry of Education Kabar Aye Pagoda Rd, Yangon Republic of the Union of Myanmar Tel: (9567) 404 483 Fax: (9567) 404 011 Web: <a href="https://www.dri.gov.mm/about-us/">https://www.dri.gov.mm/about-us/</a></td>
</tr>
<tr>
<td>SINGAPORE</td>
<td>English</td>
<td>For collective/certification marks as well as for GI registration: usually, 9 months, if applications do not contain any deficiencies or face any objection. Otherwise, processing time may be longer.</td>
<td>GI registration: SGD10,085 (EUR 660) renewal: SGD940 (EUR 618) Collective/certification mark — registration online filing: SGD580 (EUR 381) manual filing: SGD714 (EUR 470) renewal: SGD380 (EUR 250)</td>
<td>Intellectual Property Office of Singapore (IPOS) Address to the Registry of Geographical Indications for GI applications 51 Bras Basah Road #01-01 Manulife Centre Singapore 189554 Tel: (65) 6339 8616 Fax: (65) 6339 0252 Web: <a href="http://www.ipos.gov.sg">http://www.ipos.gov.sg</a></td>
</tr>
<tr>
<td>THAILAND</td>
<td>Thai language or Thai translation</td>
<td>Between 10 and 12 months</td>
<td>GI registration: THB500 (EUR 13.96)</td>
<td>Department of Intellectual Property (DIP) Ministry of Commerce 563 Nonthaburi Road Bangkraos Muang Nonthaburi 11000 Thailand Tel: (66 2) 547 46 21 to 5 (66 2) 547 46 52 Fax: (66 2) 547 46 51 / (66 2) 547 46 96 Web: <a href="http://www.ipthailand.go.th/en/">http://www.ipthailand.go.th/en/</a></td>
</tr>
<tr>
<td>VIETNAM</td>
<td>Vietnamese, and Vietnamese translation of: - Power of attorney; - Documents evidencing the right to registration; - Documents evidencing the priority right; - Other documents supporting the application.</td>
<td>Between 9 to 12 months for GI registration Between 12 and 15 months for collective/certification mark registration</td>
<td>GI Registration: 2090000 (EUR 82) Collective/certification mark — registration VND1360000 (EUR 54) renewal VND1200000 (EUR 47)</td>
<td>National Office of Intellectual Property of Vietnam (IP Vietnam) 364-386, Nguyen Trai Street Thanh Xuan District Ha Noi Tel: (844) 3558 8217 (844) 3858 3069 / (844) 3557 2091 Fax: (844) 3557 2090 (844) 3858 3328 / (844) 3858 8449 Web: <a href="http://www.nosp.gov.vn/en/web/english/home">http://www.nosp.gov.vn/en/web/english/home</a></td>
</tr>
</tbody>
</table>
d. Duration of the protection

The duration of protection for GIs is generally, but not always, indefinite under *sui generis* systems, while protecting GIs through collective or certification marks entails the need to renew such protection periodically.

Please find below, the table summarising the period of GI protection and possible renewability (when applicable) in each SEA country.

<table>
<thead>
<tr>
<th>SEA COUNTRY</th>
<th>TYPE</th>
<th>PERIOD OF PROTECTION</th>
<th>RENEWAL</th>
</tr>
</thead>
<tbody>
<tr>
<td>BRUNEI</td>
<td>Collective/certification mark</td>
<td>10 years from the filing date, which is the date of registration</td>
<td>For further periods of 10 years each — a renewal application must be filed 6 months before the expiry of the registration</td>
</tr>
<tr>
<td>CAMBODIA</td>
<td>GI</td>
<td>Indefinitely — from the date of the filing of the application, provided that it is not cancelled or invalidated in Cambodia or in its country of origin</td>
<td>Not applicable</td>
</tr>
<tr>
<td>INDONESIA</td>
<td>GI</td>
<td>Indefinitely, as long as the characteristics and/or quality used as the basis of its registration still exist</td>
<td>Not applicable</td>
</tr>
<tr>
<td>LAOS</td>
<td>GI</td>
<td>Unlimited — from the date of the filing of the application, provided that its registration is not cancelled or invalidated according to the law in Laos</td>
<td>Not applicable</td>
</tr>
<tr>
<td>MALAYSIA</td>
<td>GI</td>
<td>10 years</td>
<td>For periods of 10 years each — a renewal application must be filed before the date of expiry of the registration</td>
</tr>
<tr>
<td>MYANMAR</td>
<td>GI</td>
<td>Indefinitely — as long as the distinguishing characteristics, quality or reputation for which protection was initially granted still exist</td>
<td>Not applicable</td>
</tr>
<tr>
<td>PHILIPPINES</td>
<td>Collective / Certification mark</td>
<td>10 years — subject to the filing of a declaration of actual use or to the showing of valid reasons on the existence of obstacles to such use within 1 year from the 5th anniversary of the registration date</td>
<td>For periods of 10 years</td>
</tr>
</tbody>
</table>
| SINGAPORE  | GI   | GIs: 10 years from the date of registration  
Collective/certification marks: 10 years from the filing date of the application | GIs: every 10 years from the date of registration  
Collective/certification marks: every 10 years with proper use of the mark |
|            | Collective/Certification mark | | |
| THAILAND   | GI   | Indefinitely — as long as the requirements to be a GI remain | Not applicable |
| VIETNAM    | GI   | GI: Indefinite validity beginning on the grant date  
Collective/certification mark: 10 years from the granting date | For GIs: not applicable  
For collective/certification marks: for consecutive terms of 10 years |
4. Enforcement of rights

By protecting your GI, you can more effectively take measures against those who use your IP without your permission and benefit from its reputation. However, it is important to note that unlike trade marks, GIs do not give you sole rights. Any producer that complies with the requirements set up in the GI product specifications, that operates in the defined geographical area, and whose products are subject to the necessary controls, may use the GI. In some countries like Vietnam, it is also necessary to apply for registration as GI users and, for collective/certification marks, users need to be authorised by the GI right holder.

Despite the fact that most ASEAN countries have progressively built good laws and regulations, IP infringements are relatively common throughout SEA. In particular, the increasing interest of ASEAN consumers in quality products linked to a specific origins inspires ‘free-riders’ to unlawfully label other products using GI names. They seek to profit from the reputation of well-known GIs while misleading the consumer as to the true origin of the goods, in order to sell products at higher prices, despite the fact that they are not elaborated in the indicated area or do not comply with the production practices described in the GI product specifications.

Due to the territorial nature of IPR in ASEAN, enforcement against infringements without registration in advance is very difficult. The regular surveillance of your GI in the market is crucial to detect infringements and take action through local authorities. As GI right holders, you are usually responsible for carrying out the market surveillance of your GI products, but in some countries like Indonesia, the law also encompasses market supervision by the central and/or regional government. Aspects to be surveyed include:

- The maintenance of the reputation, quality and characteristics of the GI, so that the GI exists in the same state in which it was registered;
- The unlawful use of the GI by third parties.

Considering the different existing systems used to protect GIs in ASEAN countries (explained in Section 2 of this guide), enforcement avenues to act against infringements must be assessed, taking into consideration the concerned country and the existing legal framework for the protection of GIs therein.

Before choosing an action against a GI infringement, it is highly advisable to assess the possibility of an amicable solution, through negotiation or third-party mediation via legal professionals. In fact, the lack of IPR awareness among the general public, still frequent in most ASEAN countries, often results in abuses by infringers who do not know that their actions are illegal, and only see their acts of imitation as the sincerest form of flattery. In those cases, a warning or cease and desist letter explaining the existence of a protected right through a GI and instructing the infringer to cease their activities may stop the infringement in a quick and cost-efficient manner. Likewise, negotiations with local SMEs can be useful, explaining the possible time and costs that a court action may entail, to make them stop their unlawful actions. In countries like Cambodia, Laos, Myanmar and Singapore, private mediation to solve disputes amicably seems to be a more viable option, especially for SMEs with limited budgetary constraints, because litigation is generally expensive and time-consuming, as IP infringement cases are often handled through a complicated multi-level judicial system.

Nevertheless, negotiating may not be effective when infringers are well aware of their actions and still persist. For those cases, depending on the nature and severity of the infringement as well as on the options available in each country, there are several avenues of enforcement that you can consider:

a. Administrative actions

In countries like Vietnam, the procedure to undertake administrative actions is extensively developed and it is particularly useful when dealing with small-scale infringers. Others countries, such as Cambodia, also provide administrative proceedings to take action against IP violations of GIs. In the Philippines, administrative actions and even other amicable solutions seem to be faster enforcement avenues. On the contrary, countries like Brunei, Indonesia, Laos, Malaysia, Myanmar, Singapore or Thailand limit their enforcement options to civil and criminal actions.

These measures are applied to handle acts of infringement at the request of GI holders, organisations or individuals that detect, and suffer from, the damage caused by those acts; or when detected by competent bodies. Administrative actions are usually filed with an administrative authority rather than a court. The procedures for imposing sanctions after acts of infringement and for providing remedies, the forms those sanctions take and the level to which they are applied, vary from one country to another.

Infringing organisations and individuals may be subject to different kinds of sanctions:

- Primary sanctions, such as a warning or a fine;
- Additional sanctions, such as the confiscation or destruction of infringing goods and the means used in the commission of the violations, and the deprivation of the right to use the GI;
- And other remedies, such as the removal or destruction of elements used mainly for producing or trading these goods, the forcible modification or addition of indications on the GI, the forcible public correction of errors when faulty indications have been given on the GI, and the forcible confiscation of dispersed material evidence or means of violation, etc.

b. Civil enforcement

All countries in SEA provide, in a more or less developed manner, civil litigation in court as a means to claim compensation from infringing acts. In some countries, like Vietnam, a civil action is possible even during or after a criminal prosecution or an administrative action on the same acts.

The procedures for civil litigation and the application of civil measures must comply with the provisions made by the relevant laws on civil procedures. Taking civil actions against a GI infringement may result in injunction orders to stop the infringing activities (preliminary or permanent) or restraining
orders, awards, the disposal of infringing goods, and claims for damages, lost sales and infringer’s profits, etc.

The choice of civil litigation also varies from country to country. In Brunei, for example, civil proceedings are the easiest avenue for enforcement for most IP owners facing infringements, including rights holders who protect their GIs through collective or certification marks. In Vietnam, the choice of pursuing civil action is taken to address large-scale infringements, but it is not normally used due to the lack of IP knowledge among judges. Likewise, in the Philippines civil litigation is not common because it tends to be time consuming and expensive. Conversely, Malaysia sets out a recommended timeframe of nine months for civil cases to proceed to trial, which ensures efficiency when bringing cases before the courts.

c. Criminal prosecution

Criminal measures are applied to handle acts of infringement that contain criminal elements in accordance with the provisions made in the penal legislation in the concerned country. All ASEAN countries have legal provisions to hold infringers liable for criminal activities. The application of criminal measures complies with the provisions of the law on criminal procedures in each country.

A criminal prosecution usually results in a raid or similar enforcement actions, against suspected counterfeiters or manufacturers of pirated goods. This is followed by the possible seizure and destruction of goods, the payment of fines, the payment of damages, the withdrawal of business licenses, and even an imprisonment term for the infringer.

Criminal prosecution is considered the most cost-effective enforcement route in countries like Brunei, Indonesia, Malaysia, Myanmar and Thailand. In others, like Vietnam, criminal actions seem to be unfeasible in practice, due to the lack of knowledge among the relevant authorities, the long duration of the process and the inconsistency of the results (where the cost of litigation may not be compensated by the amount of damages awarded). In Singapore, a criminal action would not result in compensation for damages, therefore it is advisable to also take a civil action.

d. Customs’ control procedure

In all SEA countries, customs authorities can monitor import or export goods, detain or seize them if they are determined or suspected to be counterfeited, and even destroy them if they are fake.

Customs measures may be adopted ex officio by the border control authorities or in response to a complaint raised by the GI holder. In both cases, the objective is to prevent the infringing goods from entering the country and being sold.

These measures may include inspection, supervision, temporary suspension of customs procedures for allowing export and import of goods, control of goods infringing IPR, etc.

In countries like Myanmar, the Philippines, Thailand and Vietnam it is also possible to voluntarily record an IPR that has been registered with the local customs authorities. This may facilitate the work of customs authorities in recognising counterfeit products and blocking them at the border.

However, customs measures usually apply only to counterfeited products appearing as the original product, but do not apply to fake products that appear to be closely similar but not identical to the genuine ones. This is problematic in cases of misuse, or evocation or imitation of GIs (accompanied by expressions that seek to mislead consumers as to the true origin of the products). Furthermore, as GI rights are still quite new in most ASEAN countries, it may be challenging for customs authorities to identify infringing products; border control may be ineffective or sometimes not even put into practice.

Regardless which enforcement avenue should be chosen and depending on the options available in each country (as well as on the time and cost that will imply for your company), it is highly advisable to always set aside a budget for IPR enforcement when entering a new market in SEA. This also applies to GIs. Seeking professional advice to develop the best and most profitable strategy to defend a GI is highly recommended, as is finding the right lawyer (one who really understands the GI right and has the relevant experience to achieve successful results in cases of infringement).

It is always very important to prepare and collect adequate evidence to demonstrate your GI rights, ideally through registration in the concerned country, and to prove that the GI is being infringed upon. This means that you must be prepared to identify the offender, collect evidence and work proactively (and in close cooperation with the authorities) to defend your rights.
5. Case studies

Case study 1: Protecting Champagne in ASEAN

Background
Champagne is a wine exclusively produced from grapes grown, harvested and made into wine within the delimited Champagne region in France. The grapes used to make Champagne wines possess characteristics not found anywhere else in the world due to the particular geography, soil and climate of the region.

Champagne wines are produced by natural yeast fermentation in the bottle, in accordance with strict criteria laid down in the Champagne regulatory framework covering every aspect of winemaking.

The principal rules for the production of Champagne include the following:
• Just three authorised grape varieties (Chardonnay, Pinot Noir, Pinot Meunier);
• Short pruned vines (Cordon de Royat, Chablis and Guyot pruning);
• Capped grape yields per hectare;
• Juice extraction strictly limited to 102 litres of must per 160 kilos of grapes;
• Minimum annual required alcohol levels by volume;
• Dedicated Champagne wine-making and storage premises;
• A natural winemaking process known as the Méthode Champenoise;
• A minimum 15 months storage period for bottled wines prior to shipping.

Champagne has been registered as a Protected Designation of Origin in the European Union since 1973.

The overall turnover of Champagne reached almost EUR4.9 billion in 2018, of which 2.8 billion were for export.

France and the United Kingdom represent 60% of total sales, while export beyond the EU is increasingly dynamic, particularly in distant markets such as the United States of America, Japan, the Chinese world (China, Hong Kong, Taiwan) and Australia. The Champagne market is also developing in other countries like Canada, Mexico and South Africa.

Founded in 1941, the Comité Interprofessionnel du Vin de Champagne (CIVC) — Comité Champagne, is the trade association that represents the interests of independent Champagne producers (vignerons) and Champagne Houses. Its mandate is to promote the wines and wines of Champagne through a broad remit that includes: economic, technical and environmental development; continuous quality improvement; sector management; marketing and communications; and the promotion and protection of the GI ‘Champagne’ across the world.

Actions taken:
The Comité Champagne operates via a global network of bureaus in 16 of the biggest export markets for Champagne. Their job is to protect the image of Champagne within their respective markets and report the misuse of its name. Some disputes may be settled out of court, some go to trial.

The reputation and importance of the Champagne appellation has long been a source of envy for other producers, spawning hundreds of imitations every year. Some brands are easy to copy, but Champagne is a unique product born of the shared heritage of vignerons and Champagne Houses whose livelihoods depend on protecting that heritage.

They also have a duty to protect consumers against misleading claims made for any wines, beverages or products that trade off Champagne’s reputation as an appellation of guaranteed origin and quality.

It is therefore the policy of the Comité Champagne to prosecute anyone who misappropriates the reputation or identity of the Champagne appellation.

Regarding the SEA region, the Comité Champagne has been taking a leading role in the protection of the GI ‘Champagne’, taking into account its increasing presence — Champagne shipments to the Asian continent represented 20% of the appellation’s export turnover in 2018 and recorded particularly dynamic growth over the last five years (+ 40% in value).

As of 2019, the protection of the GI ‘Champagne’ was ensured through GI registration in Indonesia, Malaysia, Myanmar, and Thailand, through bilateral agreement in Singapore and through common law in Brunei and Philippines. It will soon also be protected in Vietnam (the GI has not yet entered into force).

Very recently, the Director General of the Comité Champagne officially received the registration certification for the GI ‘Champagne’ in Laos (Pakse, on 25 April 2019) and in Cambodia (Phnom Penh, 29 April 2019). The Director of the CIVC welcomed the fact that Champagne constitutes the first foreign GI to be registered in these two ASEAN countries, being part of the strategy led by the Comité Champagne which aims at ensuring the protection of the GI ‘Champagne’ everywhere in the world.

Source: ‘Champagne — From cellar to table’ (https://www.champagne.fr/en/multimedia-library)
Case study 1: Protecting Champagne in ASEAN

Outcomes
The first priority of the CIVC is to prevent misuse of the name ‘Champagne’ to describe sparkling wines; whether it is fakes being passed off as Champagne, or sparkling wines from other regions that use the name Champagne as a generic term (e.g. American Champagne).

In order to do so, the Comité Champagne remains engaged in ensuring the protection of the GI name in target markets through registration where available, not only for securing the rights of the members of the CIVC, but also for providing them with an IP tool to enforce their rights against infringement. As a result, the Champagne appellation is at present protected in 121 countries around the world within the framework of national registration systems or by bilateral or multilateral agreements protecting GIs, and this includes all 10 countries of SEA.

Lessons learned
EU GI holders are becoming more aware of the importance of securing IP protection in target export markets in order to ensure strong development at an international level using reliable tools to protect their products from infringement.

The experience of Champagne has taught us that:
• Undertaking a prior assessment on the export potential of the GI, as well as on the means of protection available in the target markets, is crucial to deciding the most appropriate jurisdictions to operate in and the systems of protection to use (Comité Champagne has set up a global network of bureaus on key export markets);
• Applying for protection in a target market must be the priority of any company or association willing to export its products to a new market;
• Registering the GI will always provide GI holders with a powerful tool to take action against the misuses of their GI.

Case study 2: Actions of Parmigiano Reggiano against infringements

**Background**

The very well-known Italian GI ‘Parmigiano Reggiano’ is a GI name that identifies a hard cheese made with unpasteurised cow’s milk and partially skimmed by natural surface skimming. With a cylindrical shape and a size of 20–26 cm in height and 35–45 cm in diameter, it gains a minimum weight of 30 kg.

The geographical area comprises the territories of the provinces of Bologna to the west of the Reno River, Mantua to the east of the River Po, Modena, Parma and Reggio in the Emilia Region of Italy.

The cows, from which the milk to produce the Parmigiano Reggiano is obtained, are reared in the defined geographical area and are fed primarily on fodder from that territory (at least 75% of the dry matter of the fodder comes from the same area). Among other aspects required for the production of Parmigiano Reggiano, the cheese must be matured in the defined geographical area for a minimum period of 12 months, and the use of fermented forage in the cattle feed, as well as any additives and preservatives, are forbidden. The entire production is subject to tests in order to verify compliance with the GI product specifications. It can be sold as a whole wheel of cheese, in portions, or grated, but the grating, portioning and packaging must also be carried out in the defined geographical area. The unique characteristics of Parmigiano Reggiano are due to the link between the product and the natural resources, the careful elaboration process and the regular controls in the defined territory where it is produced.

The Consorzio del Formaggio Parmigiano Reggiano, the management body of the Parmigiano Reggiano cheese, goes back to 1901, but it was only in 1964, after receiving the official legal approvals, that the consortium was joined by manufacturers. It carried on, with renovated vigour, the protection activity that still characterises it today. It main tasks include the defence and protection of the Parmigiano Reggiano cheese, as well as the facilitation of trade and consumption. It promotes every initiative aimed at safeguarding the typicality and unique features of the product. One of the most important measures adopted by the consortium to protect sales of the product was to introduce, in 1964, as a mark of origin, the dotted inscription ‘Parmigiano Reggiano’ encircling the wheels of cheese, giving it its current external appearance.

The name ‘Parmigiano Reggiano’ was registered as a Protected Designation of Origin in the EU in 1996 and, ever since, stakeholders have joined forces within the consortium to promote and defend this unique product within the EU but also in foreign markets. As a result, in 2010, Parmigiano Reggiano was registered as a GI in Indonesia and Malaysia, and as a collective trade mark in Vietnam.

The activities to counter fakes, in which the consortium has been engaged for many years, have been strengthened in the last 24 months, especially in non-European countries, because that area sees the highest number of real frauds against consumers and the most damage caused to producers. This is because there are no regulations in place in many of those countries, requiring the authorities of each individual country to act ex officio for the protection of GIs.

In this context, during the first semester of 2016, the Parmigiano Reggiano consortium toured the world, especially the world of imitations and fakes, to protect the most renowned — and imitated — Italian GI in the world. Among other cases, the consortium identified three infringements of the name ‘Parmigiano Reggiano’ in Vietnam: of applications for registrations of the names ‘Reggiano’, ‘Parmesan’ (denominations already in use by the consortium) and even ‘Parmigiano-Reggiano’ preceded by the name of the producer.

According to the President of the consortium in 2016, Alessandro Bezzi, ‘In fact, such a high number of attempts to create fakes in Vietnam is unprecedented, and it’s certainly related to the increased attention paid to our product in this part of the world.’

**Actions taken:**

The consortium strengthened the protection of Parmigiano Reggiano against infringements through several actions:

- A strategy backed up by a committed investment to stop infringements, which allowed the consortium not only to contest unlawful activities, but also to create new space for the commercial success of Parmigiano Reggiano and, as a consequence, to promote income opportunities for producers.
- An intensified surveillance of the worldwide market in order to quickly detect any possible abuse against the GI, which allowed them to identify the three trade mark applications infringing upon Parmigiano-Reggiano (which is registered as a collective trade mark in Vietnam).
- The decision to take action against identified infringements, through which the consortium presented objections against their registration, based on the prior right of the collective mark registered in 2010 and the intention to profit from the well-known reputation of the Parmigiano Reggiano name to sell products that had no relation whatsoever to the Parmigiano Reggiano cheese.
Case study 2: Actions of Parmigiano Reggiano against infringements

Outcome
The actions taken were extremely successful and allowed the consortium to stop the registration of the infringing applications.

According to the President of the consortium: ‘The actions taken confirm that our system of protection works well and everywhere, though it still needs to be supported by institutional actions on the part of the authorities of each individual country.’

Lessons learned
• The map of fraudulent attempts against well-known GIs, such as Parmigiano Reggiano, is very extensive, due to the increasing interest that ASEAN consumers are showing in European GIs.
• Defining a strategy to regularly survey export markets for possible infringements on a GI is crucial for detecting abuses (that may be prevented if quickly acted upon).
• Registering the GI will always provide GI holders with a powerful tool to take action against infringements with local authorities.
• Taking quick action against identified infringements, such as objecting to an application, may avoid having to take more complex legal actions later, if those trade marks manage to be registered.
• Counter-actions against infringements will always be a strong deterrent for companies that have no misgivings about using denominations or deceptive wording to evoke a GI.

(Source: https://www.parmigianoreggiano.com/)
6. Take-Away Messages

- ASEAN countries have an increasing interest in high-quality products from the EU, opening promising market opportunities for European GIs.

- Due to the territorial nature of IPR, you must assess the legal framework in each country of the SEA region in order to apply for registration to protect your GI.

- In order to decide the protection system for your GI in ASEAN countries, seeking the advice of local IP experts is highly recommended in order to identify the protection system(s) available in the target country, as well as the most cost-effective system of enforcement in cases of infringement.

- Bilateral FTAs between the EU and several ASEAN countries may offer interesting means of direct recognition and protection to some EU GIs.

- Registering your GI in ASEAN countries will always offer a safer option than accessing the region without any protection for your GI.

- Watch out for GI infringements! Registering your GI will not prevent counterfeiting; the regular surveillance of your GI in the market is crucial for detecting wrongful uses of your GI and taking immediate action against infringements.

- Envisaging a budget forecast for GI enforcement, seeking professional advice to define a strategy for defending your GI, and gathering the maximum amount evidence possible to prove both your rights and the infringement that your GI faces, are all highly recommended measures for achieving successful results in cases of GI infringement.

7. Glossary of Terms

TRIPS Agreement:
The Trade-Related Aspects of Intellectual Property Rights Agreement is Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, signed in Marrakesh (Morocco) on 15 April 1994, establishing basic principles for the protection and enforcement of intellectual property by WTO members.

GI product specifications (known in some ASEAN countries as the ‘Book of Specifications’ or the ‘Book of Requirements’): This is the most important document of the GI, comprising all technical information regarding its characteristics, elaboration and its links with its origin. The GI Product Specifications usually contain: the name to be protected as a GI; a description of the product, including the raw materials, if appropriate, as well as the principal physical, chemical, microbiological or organoleptic characteristics of the product; the definition of the geographical area of the GI; evidence that the product originates in the defined geographical area; a description of the method of obtaining the product; details establishing the link between the quality or characteristics of the product and the geographical environment, or the link between a given quality and the reputation or other characteristics of the product and the geographical origin; the name and address of the authorities or bodies verifying compliance with the provisions of the product specifications; and any specific labelling rules for the product.

Memorandum of Understanding (MoU):
This is a type of agreement between two (bilateral) or more (multilateral) parties, expressing a convergence of will between the parties, and indicating an intended common line of action. It is often used — either in cases where parties do not imply a legal commitment or in situations where the parties cannot create a legally enforceable agreement. Whether or not a document constitutes a binding contract depends only on the presence or absence of well-defined legal elements in the text of the document. Laos signed a MoU with several ASEAN countries (Cambodia, Singapore and Vietnam) that already have GIs registered in order to accelerate the examination process, reducing the average time to issue the GI certificate to between 1 and 3 months.

Priority rights:
It is a time-limited right, triggered by the first filing of an application for a GI or a trade mark. The priority right allows the claimant to file a subsequent application in another country for the same GI or trade mark (effective from the date of filing the first application). When filing the subsequent application, the applicant must claim the priority of the first application in order to make use of the right of priority.
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8. Related Links


- ASEAN GI Database: http://www.asean-gidatabase.org/gidatabase/

- World Trade Organization (WTO) TRIPS Agreement, Geographical Indications: https://www.wto.org/english/docs_e/legal_e/27-trips_04b_e.htm#3


- Brunei Darussalam Intellectual Property Office (BruiPO): http://www.bruipo.gov.bn

- Cambodia Department of Industrial Property (DIP): http://www.mih.gov.kh/


- Department of Intellectual Property within the Ministry of Science and Technology in Laos: https://dip.gov.la/


- Visit our IP Country Factsheets webpage: https://www.southeastasia-iprhelpdesk.eu/country-guides


- Visit other publications at the SEA IPR SME Helpdesk website: www.ipr-hub.eu

- Visit the Helpdesk blog http://www.yourIPinsider.eu for related articles on IP in SEA and China
Free South-East Asia IP advice for European SMEs

> For more information and to discuss how we can work together, please contact us:
Tel: +84 28 3825 8116 | Tel: +32 2 663 30 51
Email: question@southeastasia-iprhelpdesk.eu
Online: www.ipr-hub.eu

> If you have a question about protecting intellectual property in any South-East Asia country, please contact our free confidential helpline at:
question@southeastasia-iprhelpdesk.eu

Guide developed in February 2020 in collaboration with: the Geographical Indications (GI) Expert and Senior IP Quality Control Advisor of the SEA IPR SME Helpdesk, Ester Olivas Cáceres.

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